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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,365	10/17/2001	Bradley P. Lane	LANEB.55838	7814
27629	7590	07/13/2004	EXAMINER	
FULWIDER PATTON LEE & UTECHT, LLP 200 OCEANGATE, SUITE 1550 LONG BEACH, CA 90802			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,365

Applicant(s)

LANE, BRADLEY P.

Examiner

Mark T Henderson

Art Unit

3722

CC

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-36 is/are pending in the application.
- 4a) Of the above claim(s) 2-15, 17 and 34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-33 is/are allowed.
- 6) ☒ Claim(s) 1, 35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Attachment I</u> . |

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 18 and 35 have been amended for further examination. The specification has been amended to overcome the previous drawing objections.

Art Unit: 3722

Election/Restriction

2. This application contains claims 2-15, 17 and 34 drawn to an invention nonelected with traverse in Paper No. (3/26/03 - Mail Date). A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 18-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not understood how the slot identifiers are “unique”. Applicant must disclose its uniqueness in detail.

Art Unit: 3722

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 35 is finally rejected under 35 U.S.C. 102(b) as being anticipated by Liener Chin et al (6,632,042).

Liener Chin et al discloses in Fig. 21-23, a method for organizing comprising: providing a looseleaf page for a display album (Fig. 21) having storage sleeves forming pockets (910 in Fig. 23) with an opening (A) along one side (A1), a viewing window (910A) for viewing a collectible materials; wherein the pocket has indicia (written in 920); and wherein a display item is placed in the pocket; generating and attaching a table of contents (890 in Fig. 22) to the display album including a listing of material descriptors (884); assigning positional identifiers (854) to respective material descriptors.

In regards **Claim 35** wherein the pocket indicia is matching the positional identifier so that a user may determine the location of collectible materials; and material descriptors corresponding to unique indicia of respective pockets, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

Art Unit: 3722

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The pocket indicia of Liener Chin et al is capable of disclosing indicia matching positional identifiers; and wherein the material descriptors are capable of corresponding to unique pocket indicia.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al (6,632,042) as modified by Brotschi (3,837,104), in view of Staar (5,136,562) and further in view of Vineyard et al (6,265,043).

Liener Chin et al discloses in Fig. 21-23, a method for organizing comprising: providing a looseleaf page for a display album (Fig. 21) having storage sleeves forming pockets (910 in Fig. 23) with an opening (A) along one side (A1), a viewing window (910A) for viewing a display

Art Unit: 3722

window (910A) for viewing a display item; wherein the pocket has indicia written in space (920); and wherein a display item is placed in the pocket.

However, Liener Chin et al does not disclose: a liner note inserted in a pocket of a loose leaf page; a selection of a plurality of compact discs, each disc having a title and a liner note; wherein the compact discs are to be organized in the slots of a compact disc changer placed in the respective slots.

Brotschi discloses in Fig. 3, a loose leaf page of an album comprising storage sleeves pockets (22) with an inserted liner note (26).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's method of organizing with an album page having a sleeve pocket with an inserted liner note as taught by Brotschi for the purpose of alternatively displaying indicia information.

However, Liener Chin et al as modified by Brotschi does not disclose a selection of a plurality of compact discs, each disc having a title and a liner note; and wherein the compact discs are to be organized in the slots of a compact disc changer placed in the respective slots.

Vineyard et al et al discloses in Fig. 1, a compact disc (A) having a title (30) and a liner note (28) with printed indicia.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's and Brotschi's method of organizing

Art Unit: 3722

organizer to include a compact disc as a display item having a title and a liner note with printed indicia as taught by Vineyard et al et al for the purpose of displaying a labeled compact disc.

However, Liener et al as modified by Brotschi and Vineyard et al do not disclose wherein the compact discs are to be organized in the located slots of a compact disc changer placed in the respective slots and selected.

Staar discloses in Fig. 1-3, a plurality of compact discs organized and placed in the slots (24) of a compact disc changer, wherein the located slots have a slot identifier (20 in Fig. 2); wherein the compact discs are selected (Col. 3, lines 36-42).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's, Brotschi's and Vineyard et al's method of organizing with compact discs as display items which can be stored and identified in a located slot of a disc changer as taught by Staar for the purpose of providing compact discs which can be placed in a CD changer.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia on the CD, pocket, and slot, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. Therefore, the indicia associated with the liner in the Vineyard et al reference can recite any information desired by the end user. Furthermore, in regards to the pocket indicia matching the respective slot identifier so

Art Unit: 3722

that a user may determine the location of compact discs; and wherein the slot identifiers are unique, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The pocket indicia of Lien Chin et al is capable of disclosing indicia matching slot identifiers, and wherein the slot identifiers are capable of being unique.

6. Claim 36 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al in view of Vinyard et al, and further in view of Bakke et al (6,135,662).

Liener Chin et al discloses a method of organizing comprising all the elements as claimed in Claim 35, and as set forth above. However, Liener Chin et al does not disclose a first set of stickers which are placed on a respective pocket; and a second set of stickers placed on the collectible item.

Vinyard et al discloses stickers which can be placed on a collectible items such as a compact disc.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's method for organizing with a label on a collectible item such as a compact disc as taught by Vinyard et al for the purpose of describing the contents of the collectible item.

Art Unit: 3722

However, Liener Chin et al as modified by Vinyard does not disclose a sticker placed on a pocket.

Bakke et al discloses in Fig. 1 and 7, a label (104) placed in a pocket which is placed on top of a storage pocket (48).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's method of organizing by providing a label placed and secured on a pocket as taught by Bakke et al for the purpose of labeling the pockets contents.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a pocket or sleeve in place of adhesive, since the examiner takes Official Notice of the equivalence of securing a label substrate by placing it in a pocket or sleeve to that of having adhesive placed on the substrates backside to secure it to an item, and the selection of any of these known equivalents to secure an item would be within the level of ordinary skill in the art.

Furthermore, in regards to the stickers of the second set to correspond to the stickers of the first set, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the stickers from Bakke et al and Vinyard et al are capable of corresponding with each other.

Art Unit: 3722

Allowable Subject Matter

7. Claims 18-33 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses or fairly suggest a display apparatus comprising an elongated spine member having an upper flange folded to form an upper rearwardly facing retention recess and a lower flange folded to form a lower rearwardly facing retention recess, wherein both flanges are located at opposing longitudinal margins of the spine; a first cover member including an innermost end having a first flexible hook inserted into the upper the retention recess from an external spine side direction, and wherein the cover member includes display sleeves openable at one end and having a transparent viewing surface; a second cover member including an innermost end having a second flexible hook inserted into the lower retention recess form an external spine side direction; wherein the hooks cooperating with the flanges to pivotally attach the cover members to the spine; a plurality of flexible loose leaf pages having a gutter section positioned between a display section and a perforated hinge section; the display section having at least one formed pocket with a non-woven backing an opposing transparent viewing window for viewing of inserted liner notes;; and a plurality of detachable post members projecting between the upper flange and the lower flange securing the first and second members to the spine and further passing through the perforated hinge section of the pages to releasably secure the pages to the spine, and whereby the

Art Unit: 3722

posts may be disconnected and reconnected to secure the pages between the first and second cover members; and including all of the other limitations of the independent claim.

Response to Arguments

In regards to applicant's arguments that the Liener Chin et al does not disclose the structure of the table of contents as a linking medium between the material descriptors, positional identifier, unique indicia, and collectible materials providing a searching aid so that a user may flip to the desired page wherein a sought for collectible material is stored without having to search the entire display album, the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the table of contents of Liener Chin et al is capable of being a linking medium.

In regards to applicant's arguments that Liener Chin et al does not disclose unique indicia and unique positional identifiers, wherein "by unique, it is meant that each pocket has unique indicia and each collectible material is assigned a unique positional identifier", wherein for

Art Unit: 3722

example the pockets may be sequentially numbered and the first pocket will be assigned unique indicia numeral one while the collectible material to be stored in pocket numeral one will also bear the numeral one”, the examiner submits that the features upon which applicant relies (i.e., unique indicia defines a one to one correlation between each descriptor, its respective indicia and corresponding identifier) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regards to applicant’s arguments that there is no suggestion to combine the references of Liener Chin et al with Vinyard, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, Liener Chin et al discloses an organizer having pockets for organizing and storing “printed sheets, photographs, clippings, handwritten pages, drawings, and so forth” (as stated on Col. 1, lines 5-10). The examiner has interpreted the phrase “and so forth” as any other article (including CDS, or entertainment recordings) that need to be organized. However, Liener Chin et al does not disclose a CD article having a title and a liner. Vineyard et al discloses a CD article comprising a title and a liner note. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al’s and Brotschi’s (due to amended claim) method of organizing organizer to include a compact disc as a display

Art Unit: 3722

item having a title and a liner note with printed indicia as taught by Vineyard et al et al for the purpose of displaying a labeled compact disc. In regards to applicant's argument that a liner note is "typically in booklet form that accompanies entertainment recordings", the examiner submits again that the features upon which applicant relies (i.e., a liner note's structure is a booklet which accompanies CD's) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the examiner has interpreted a "liner note" in broadest sense as a label on a CD having printed indicia.

In regards to applicant's argument that the Staar reference does not disclose or suggest equating the location of liner notes within a display apparatus such as a binder with the location of corresponding discs within the CD changer, the examiner submits that the Staar reference is only relied upon for showing a plurality of compact discs organized and placed in the slots of a compact disc changer, wherein the located slots have a slot identifier; and wherein the compact discs are selected. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's, Brotschi's and Vineyard et al's method of organizing with compact discs as display items which can be stored and identified in a located slot of a disc changer as taught by Staar for the purpose of providing compact discs which can be placed in a CD changer.

In regards to intended use of equating the liner notes within the display apparatus with the location of corresponding CD, a recitation of the intended use of the claimed invention must result

Art Unit: 3722

in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the liner notes of Liener Chin et al as modified by Vineyard et al is capable of being equated to any corresponding article as desired by the end user.

Therefore, the rejection have been maintained.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

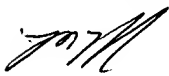
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

Art Unit: 3722

will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, a. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

July 11, 2004



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

